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In re Application of:
RASMUSSEN, Steen, Barbrand
U.S. Application No.: 10/501,224
PCT No.: PCT/DK03/00011
International Filing Date: 09 January 2003
Priority Date: 10 January 2002
Attorney's Docket No.: 66722-057-7
For: PIEZO ELECTRIC PUMP AND
DEVICE WITH SUCH PUMP

DECISION ON RENEWED
PETITION UNDER
37 CFR 1.47(b)

In a decision mailed by this Office on 19 May 2005, the petition under 37 CFR 1.47(b) was dismissed without prejudice for failing to satisfy all the requirements of a grantable petition. Specifically, petitioner had not submitted: (1) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (2) an adequate showing that the 37 CFR 1.47(b) applicant has a proprietary interest in the present application; and (3) a statement that granting the petition is necessary to preserve the rights of the parties or to prevent irreparable damage.

On 18 July 2005, petitioner filed the renewed petition considered herein. The renewed petition includes a declaration executed on behalf of the nonsigning inventor by "Niels Jacobsen, Chairman of the Board." The renewed petition states that Mr. Jacobsen is Chairman of the Board of Interacoustics A/S Assens, the 37 CFR 1.47(b) applicant ("Interacoustics"). This declaration satisfies the oath or declaration requirement of a grantable petition under 37 CFR 1.47(b).

The petition also includes a statement from counsel that the granting of this petition is necessary to preserve the rights of the parties or prevent irreparable damage, satisfying this requirement.

With respect to petitioner's proprietary interest in the application, petitioner has submitted a document entitled "Legal Opinion – Ownership of IPR created by Mr. Steen B. Rasmussen during employment in the William Demant Holding Group" executed by Troels Libak Stollberg, identified as Vice President, Legal Affairs for William Demant Holding A/S ("WDH").¹ The Legal Opinion does not reference a specific assignment of the application by the inventor, and it states that the inventor's employment agreement did not specifically address intellectual property rights; nonetheless, the Legal Opinion concludes that under the applicable Danish law, Interacoustics is the owner of the present application and the underlying invention.

¹ The Legal Opinion identifies WDH as the parent corporation of 37 CFR 1.478(b) applicant Interacoustics.

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Section 409.03(f) states the following concerning situations like the present case:

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

The Legal Opinion submitted by petitioner here does not satisfy the MPEP requirements set forth above. For example, the Legal Opinion is based on the presumed fact that the nonsigning inventor made the present invention during the course of his duties with Rhinometrics A/S; however, no firsthand evidence is presented to support this assertion (it is not clear that the attorney submitting the document has the required firsthand knowledge, and no supporting affidavits or declarations have been provided). Similarly, the Legal Opinion asserts that the inventor "accepted to let some of his inventions be patented in the name of [Interacoustics]" without providing evidentiary support for this assertion. In addition, the Legal Opinion is based on a foreign statute (the Danish Employee Interventions Act) and a decision of a Danish court; however, English language translations of this statute and decision have not been made of record.

Based on the above, the present submission is insufficient to demonstrate that Interacoustics' has the required proprietary interest in the present application. Accordingly, the final element of a grantable petition under 37 CFR 1.47(b) is not satisfied.

CONCLUSION

Applicants' renewed petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

Any request for reconsideration must be filed within **TWO (2) MONTHS** of the mail date of the present decision and should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.47(b)" and the additional materials required to bring the present assertion of proprietary interest into compliance with the requirements of the MPEP, as discussed above.

Failure to provide a proper and timely response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT,
Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria,
Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT
Legal Administration.



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